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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/725,406	12/03/2003	Jack Wang	WANG157	4745
1444	7590	06/02/2005	EXAMINER	
BROWDY AND NEIMARK, P.L.L.C. 624 NINTH STREET, NW SUITE 300 WASHINGTON, DC 20001-5303			WATKINS III, WILLIAM P	
			ART UNIT	PAPER NUMBER
			1772	

DATE MAILED: 06/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/725,406

Applicant(s)

WANG, JACK

Examiner

William P. Watkins III

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 1-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-11, drawn to a method of making a grip strip with coating or dipping, classified in class 427, subclass 430.1.

II. Claims 12-20, drawn to a grip strip with filled holes, classified in class 428, subclass 139.

2. The inventions are distinct, each from the other because of the following reasons:

3. Inventions Group I, claims 1-11 and Group II, claims 12-20 are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed could be made by injection molding the polymer from both sides of the substrate in order to fill the holes.

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4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and since the fields of search are not co-extensive, restriction for examination purposes as indicated is proper.

5. During a telephone conversation with Mr. Sheridan Neimark on 23 February 2005 a provisional election was made with traverse to prosecute the invention of Group II, claims 12-20. Affirmation of this election must be made by applicant in replying to this Office action. Claims 12-20 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

6. The examiner notes that applicant has confirmed the election in a paper filed 24 February 2005 with traverse. Applicant is asked to present any arguments regarding traverse in any response filed to the instant office action.

7. Claim 12 is objected to because of the following informalities: spelling of "sad" line 3 of claim 12. Appropriate correction is required.

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8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claim 12, 15 and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Chen et al. (U.S. 2004/0109980).

Chen et al. teach a perforated felt with a polyurethane coating the fills the perforations (Figure 3, abstract, section (0012)). The examiner takes the fibers of the felt as comprising either natural or synthetic polymer.

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter

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pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. Claims 12, 13, 14, 15, 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al. (U.S. 2004/0109980) in view of Huang (U.S. 2003/0198803).

Chen et al. teach a coated perforated felt as noted above. Huang teaches the used of a foam EVA material instead of felt as the backing for a polyurethane top layer in order to provide better cushioning (abstract). The instant invention claims the use of a perforated EVA base with a polyurethane coating. It would have been obvious to one of ordinary skill in the art to have used a perforated EVA base instead of perforated felt in the laminate of Chen et al. in order to provide better cushioning because of the teachings of Huang.

12. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al. (U.S. 2004/0109980) in view of Huang (U.S. 2003/0198803) as applied to claims 12, 13, 14, 15, 17 above, and further in view of Hawley et al. (U.S. 6,221,796).

Chen et al. as modified above teaches a perforated EVA layer with a polyurethane coating. Hawley et al. teaches a

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scrim coated with a foam in order to provide a reinforced cushioning layer with through holes (abstract, col. 1, lines 30-45). The instant invention claims a scrim with polymer coating and through holes that are filled with a second polymer. It would have been obvious to one of ordinary skill in the art to have substituted an EVA foam covered scrim for the EVA layer of Chen et al. as modified above in order to reinforce the layer because of the teachings of Hawley et al.

13. Claims 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al. (U.S. 2004/0109980) in view of Huang (U.S. 2003/0198803) as applied to claims 12, 13, 14, 15, 17 above, and further in view of Kobe et al. (U.S. 6,372,323 B1).

Chen et al. teaches a perforated EVA layer with a polyurethane coating. Kobe et al. teach the use of non-woven fabric and other layers as reinforcement backings behind grip strips (col. 5, lines 15-50, col. 1, lines 55-65). The instant invention claims a perforated grip strip with a non-woven backing. It would have been obvious to one of ordinary skill in the art have used a backing layer on

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the grip strip of Chen as modified above in order to reinforce the strip because of the teachings of Kobe et al.

14. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al. as applied to claims 12, 13, 14, 15, 17 above, and further in view of Spector (U.S. 4,567,091).

Spector teaches the use of skin layers on both sides of a foam layer in order to seal it and provide better cushioning (abstract). The instant invention claims a perforated layer coated and filled from both sides by a second polymer. It would have been obvious to one of ordinary skill in the art to have coated the strip of Chen et al. as modified above on both sided to enhance cushioning because of the teachings of Spector.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Watkins III whose telephone number is 571-272-1503. The examiner works an increased flex time schedule, but can normally be reached Monday through Friday, 11:30 A.M. through 8:00 P.M. Eastern Time. The examiner returns all calls within one business day unless an extended absence is noted on his voice mail greeting.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the

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organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**WILLIAM P. WATKINS III
PRIMARY EXAMINER**

WW/ww

May 29, 2005